



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/748,807	12/22/2000	Neboisa Jovicic	3252RE	3496

7590 10/19/2004

Michael P Mazza
Niro Scavone Haller & Niro
181 West Madison Street
Suite 4600
Chicago, IL 60602

EXAMINER

KALINOWSKI, ALEXANDER G

ART UNIT PAPER NUMBER

3626

DATE MAILED: 10/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/748,807

Applicant(s)

JOVICIC ET AL.

Examiner

Alexander Kalinowski

Art Unit

3626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 July 2004.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 and 13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) 1-9 is/are allowed.
- 6) ☐ Claim(s) 10, 11 and 13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. Claims 1-11 and 13 are presented for examination. Applicant filed an amendment on 7/2/2004, amending claims 1, 10, 11, and 13 and canceling claims 12 and 14-16. A new search for prior art was necessitated by Applicant's amendment. New grounds of rejection are established for claims 10-11 and 13. Claims 1-9 are allowed

Response to Arguments

2. Applicant's arguments with respect to claims 10, 11 and 13 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 10, 11, and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barnett et al., Pat. No. 6,336,099 (hereinafter Barnett) in view of Christenson et al., Pat. No. 5,710,886 (hereinafter Christenson).

As to claims 10-11, Barnett discloses A method for selectively transmitting and using redeemable coupons comprising coupon data and data sufficient to identify each coupon , comprising the steps of.

Art Unit: 3626

generating coupon offers via a coupon server, the coupon offers comprising coupon indicia and being based on information provided by coupon issuers (col. 6, lines 52-58 and col. 11, lines 24-29) and

consumer computers in electronic communication with the coupon server over an Internet connection providing the coupon server with user indicia including demographic information about the consumers the demographic information being independent of consumer selections of the coupon offers (col. 7, lines 1-5 and line 59 – col. 8, line 1) the consumer computers comprising a user database and a browsing memory permitting the consumers to browse coupon offers on a visual display (col. 7, lines 1-5 and col. 8, lines 29-33);

the coupon server making initial coupon offers selectively available to the consumer computers accessing the Internet on the basis of the user indicia at least the initial coupon offers being selectively available to an individual consumer computer based upon the demographic information provided by the individual consumer computer, the coupon server generating new coupon offers different from the initial coupon offers and making them selectively accessible to the consumer computers based upon receipt from the coupon issuers of new coupon information as well as receipt from the consumer computers of the user indicia (col. 8, lines 14-33, col. 12, lines 29-67, col. 13, lines 4-15, lines 30-42; and

making accessible to the consumer computers electronic coupons and permitting the consumers to make on-line selections of redeemable coupon offers (col. 7, lines 1-5).

Barnett does not explicitly disclose

Art Unit: 3626

The coupon server sending coupon indicia data and consumer data to an internet
Coupon Notification Center and

Verifying at the Internet Coupon Notification Center the validity of any selected
coupons upon redemption by a consumer.

However, Christenson discloses capturing coupon data including customer data
from redeemed coupons and transmitted to a verification center (col. 15, lines 45-63). In
addition the verification center determines whether the redeemed coupon is authorized
for redemption (col. 15, lines 45-63). It would have been obvious to one of ordinary skill
in the art at the time of Applicant's invention to include the aforementioned features as
disclosed by Christenson within Barnett for the motivation of reducing fraud (col. 4, lines
50-53).

As to claim 13, Barnett discloses A method for distributing electronic coupons
(see abstract) comprising

coupon data and data sufficient to identify each coupon comprising the steps of
providing registration information to a coupon server via a network node the registration
information including demographic information (see Fig. 1 and col. 7, line 62 – col. 8,
line 13)

storing the registration information within the coupon server (col. 7, lines 62-67)

the coupon server receiving coupon indicia information from a coupon notification center

storing the coupon indicia information within the coupon server (col. 6, lines 52-57)

generating one or more electronic coupons based on the registration information (col. 8,
lines 14-19) each electronic coupon having a serial number and comprising a plurality of

Art Unit: 3626

digital representations of indicia including the coupon indicia information (i.e. user identification bar code number)(see Fig. 3 and col. 11, lines 1-23)

the coupon server making the electronic coupons accessible to remote users such that the users can select one of more of the electronic coupons (col. 8, lines 23-33)

the coupon server transmitting the coupon generation information to the coupon notification center (see Fig. 1 and col. 6, lines 58-62); and

storing the coupon generation information in a database within the coupon notification center(see unit 16, Fig. 1 and col. 6, lines 58-62).

As to claims 14 and 16, Barnett discloses A system for distributing electronic coupons comprising coupon data and data sufficient to uniquely identify each coupon (see Fig. 1 and Fig. 3) comprising

a network node that can communicate with a coupon server (Fig. 1)

the coupon server being capable of generating electronic coupon information (col. 6, lines 52-54, col. 8, lines 14-19)

the coupon server also being capable of communicating at least a portion of the electronic coupon information to the network node (col. 8, lines 14-33)

the coupon server also being capable of receiving and storing coupon indicia information (col. 6, lines 52-58) and receiving coupon verification information from a coupon notification center (col. 11, lines 11-29).

Barnett does not explicitly disclose

The coupon server sending coupon indicia data and consumer data to an internet Coupon Notification Center and

Art Unit: 3626

Verifying at the Internet Coupon Notification Center the validity of any selected coupons upon redemption by a consumer.

However, Christenson discloses capturing coupon data including customer data from redeemed coupons and transmitted to a verification center (col. 15, lines 45-63). In addition the verification center determines whether the redeemed coupon is authorized for redemption (col. 15, lines 45-63). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include the aforementioned features as disclosed by Christenson within Barnett for the motivation of reducing fraud (col. 4, lines 50-53).

Allowable Subject Matter

5. Claims 1-9 are allowed.

The claimed invention is directed to a system and method for distributing electronic coupons over an electronic computer coupon communication system.

The prior art, as evidenced by Barnett et al., Pat. No. 6,336,099, discloses a system and method for distributing electronic coupons. The prior art discloses a computer system including a network node in communication with a coupon server for receiving, storing, selecting and displaying electronic coupons. The prior art also discloses the coupon server in communication with coupon notification center including generating and transmitting electronic coupons to the network node and for recording and transmitting electronic coupon transaction information. The prior art also discloses the coupon notification center including

Art Unit: 3626

recording and updating coupon redemption information. Finally the prior art discloses an electronic coupon that includes a plurality of digital representations of product images and digital representations of indicia including expiration data, serial number, redemption data, discount information, user identification and product information. However, the prior art does not disclose or suggest an electronic coupon including plurality of digital representations of indicia identifying various fields of information and "the user's Internet Address". This feature is found in independent claims 1, 4, and 7.

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

a. Pat. No. 5,612,527 discloses an online coupon redemption method.

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any


Art Unit: 3626

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alexander Kalinowski, whose telephone number is (703) 305-2398. The examiner can normally be reached on Monday to Thursday from 9:00 AM to 6:30 PM. In addition, the examiner can be reached on alternate Fridays.

If any attempt to reach the examiner by telephone is unsuccessful, the examiner's supervisor, Joseph Thomas, can be reached on (703) 305-9588. The fax telephone number for this group is (703) 305-7687 (for official communications including After Final communications labeled "Box AF").

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 7th Floor, receptionist.



Alexander Kalinowski

Primary Examiner

Art Unit 3626

10/16/04